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10/783,668	02/20/2004	Gabriel Santos	IS01442ESG	7224

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EXAMINER

PRONE, JASON D

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/783,668

Applicant(s)

SANTOS ET AL.

Examiner

Jason Prone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2005.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
4a) Of the above claim(s) 14 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-13 and 15-18 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 20 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I in the reply filed on 05 May 2005.
2. Claim 14 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 05 May 2005.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: in Figure 1, "item 4". In Figures 3, 4, and 6, item "323". Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
4. The drawings are objected to because In Figure 4, the direction of the cut means 312 going away from the holding means 303 is labeled as 401 positive X-direction.

However, Figure 7 clearly shows the direction of the cut means 312 going towards the holding means 303 as the positive X-direction 401. The arrow in Figure 7 should be labeled as the -X-direction 402 as shown in Figure 4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "309" has been used to designate both a recess, on page 3 line 29 and coil spring, on pages 4 (lines 11, 12) and 6 (lines 13, 19). The specification should be reviewed for any additional occurrences of item 309 being used incorrectly that the examiner might have missed. Corrected drawing sheets in compliance with 37

CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The disclosure is objected to because of the following informalities: On page 3 line 21, the phrase "base member 300" should be replaced with "base member 301". On page 4 line 9, the phrase "aperture 301" should be replaced with "aperture 310". On page 5 line 7, the phrase "rails 312" should be replaced with "rails 318".

Appropriate correction is required.

Claim Objections

7. Claim 14 and 18 objected to because of the following informalities: Claim 14 has been withdrawn and therefore, should be labeled as (withdrawn) instead of (Original). Also, claim 18 should be labeled as (Original). Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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9. Claims 1-14 and 15-18 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In regards to moveable support 307, Figure 4 discloses that the structure of the movable block is the rectangle that the "307" is located on and (in view of Figures 3 and 6) the two small rectangles (directly next to the coil springs). In view of the moveable support structure, it^{is} unclear how the moveable belt is coupled to the moveable support 307. It is unclear how, the moveable support 307 moves toward the fixed block (to loosen the belt) when the small rectangles portion of the moveable support 307 is already pressed against the fixed block. Using Figures 4, 6, and 7, the position of the belt in Figures 4 and 6 appears to be in the same position as shown in Figure 7, which discloses the belt position that holds the work piece. Therefore, if the belt is in the closed or work piece holding position, as shown in Figures 3-6, it is unclear how the moveable support 307 moves the belt to the open or release position. It is also unclear how the moveable support 307 is spring-loaded. In view of the previously stated moveable support structure, Figures 3 and 4 show coil springs, that do not contact moveable support 307. The fixed block 304 has a long portion and a short portion that create an L-shaped member. The coil springs (using spring 400 in Figure 4) are clearly connected first at the long portion of the fixed block (white circle) and then to the short portion of the fixed block. The spring never touches any structure considered to be the moveable support 307.

In regards to the leveling means 403, the term "level" is defined, in Figure 7, as the position of the work piece relative to the blade. The edge of the work piece 703 is parallel to the blade. The specification states that the leveling means 403 alone permits the work piece to attain the level position that is needed to perform the cutting function. However, leveling means 403 has the structure to control the amount of insertion of the work piece but it does not have the ability to put the work piece in a level position without an additional structure. In this case, without the recess 309 putting the work piece at a right angle to the leveling means 403, the work piece could in fact come into contact with the leveling at any position. It is uncertain how item 403 alone can be considered the leveling means when in fact the recess 309 performs an important role in the leveling process.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 6 and 15-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. In regards to claim 6, the phrase "moveable belt is spring loaded against the fixed block" is unclear. It is uncertain what structure allows the belt to be spring loaded.

13. In regards to claim 15, the "at least one blade travels parallel to the top surface of the leveling means" is unclear. The way the statement is written makes it sound that the blade is moveable relative to the leveling means. Using Figure 7, leveling means is

clearly part of the blade and therefore is uncertain how the blade travels parallel to the top surface of the leveling means.

14. Claim 15 recites the limitation "the leveling means" on line 9. There is insufficient antecedent basis for this limitation in the claim.

15. In regards to claim 16, the phrase "a leveling means" is unclear. It is uncertain if the "a leveling means" is the same structure as the "the leveling means" of independent claim 15.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 1-3, 7, 8, and 10-13 are rejected, as best understood, under 35 U.S.C. 102(b) as being anticipated by Coleman (3,675,524).

Coleman discloses the same invention including a means for holding a work piece (23), a cutting means (17 and 33) comprising at least one blade (17), the blade passes across at least one surface of the work piece (Fig. 2), the cutting means further comprises a leveling means (33), the amount of insertion is limited by the leveling means (Fig. 2), a sliding member coupled to the cutting means (12), the sliding member is mounted on rails (Fig. 3), the sliding member is coupled to a lever (13), a threaded member coupled to the sliding member (7), the threaded member passes through a fixed stop (5), a threaded stop disposed about the threaded member (8) such that the

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fixed adjustment stop is disposed between the sliding member and the threaded stop (Fig. 2), travel of the cutting means is adjustable by twisting the threaded stop (8), and the cutting means is electrically isolated from the means for holding a work piece (Fig. 2).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman in view of Makeev et al. (4,077,287). Coleman discloses the invention but fails to disclose a magnet mounted below the cutting means. Makeev et al. teaches a magnet below the cutting means (39 Column 10, lines 20-25). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Coleman with a magnet, as taught by Makeev et al., to prevent the cut pieces from traveling all over.

20. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman in view of Diskin (5,135,208). Coleman discloses the invention but fails to disclose the means for holding includes a fixed block and a spring-loaded belt. Diskin teaches a means for holding that includes a fixed block (22) and a spring-loaded (64) belt (52). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Coleman with a fixed block and a spring-loaded

belt, as taught by Diskin, to allow the holding means to hold an alternate shaped work piece.

21. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman in view of Matych (1,164,658). Coleman discloses the invention but fails to disclose the lever is rotatably connected to the sliding member by way of a gear assembly. Matych teaches a lever (27) that is rotatably connected to the sliding member (24) by way of a gear assembly (Figs. 3 and 4). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Coleman with a gear assembly, as taught by Matych, to allow for a more precise method of moving the sliding member.

22. Claims 15, 16, and 18 are rejected, as best understood, under 35 U.S.C. 103(a) as being unpatentable over Coleman in view of Diskin. Coleman discloses the invention including a base member (1), a fixed block coupled to the base member (23), a moveable cutting means comprising at least one blade (17), a leveling means (27), and the cutting means is electrically isolated (17).

However, Coleman fails to disclose the fixed block includes a recess for holding the work piece, a spring loaded moveable belt, and the belt and the recess form a closed loop. Diskin teaches a fixed block (22) with a recess for holding the work piece (30), a spring-loaded (64) moveable belt (52), and the belt and the recess form a closed loop (Fig. 5). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Coleman with a fixed block and a spring-

loaded belt, as taught by Diskin, to allow the holding means to hold an alternate shaped work piece.

23. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman in view of Diskin as applied to claim 15 above, and further in view of Makeev et al. Coleman and Diskin disclose the invention but fails to disclose a magnet disposed below the cutting means. Makeev et al. teaches a magnet below the cutting means (39 Column 10, lines 20-25). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Coleman in view of Diskin with a magnet, as taught by Makeev et al., to prevent the cut pieces from traveling all over.

Conclusion

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pimentel, Imhoff, Mehler et al., Hess, Lemmer, Baudisch et al., Goss et al., Trudeau, and Norell et al.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is 571-272-4513. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JP
June 14, 2005



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